

REMARKS

In an Office Action of November 5, 2002, the Examiner indicated that a supplemental reissue oath must be included. In addition, the Examiner rejected the claims as being an improper recapture of claim subject matter deliberately cancelled in the application. Each of these issues will be addressed in turn.

Supplemental Oath Declaration

A proper reissue oath/declaration of co-inventor Edward Marue was submitted on August 13, 2001. This declaration included the language indicated in the Office Action as being necessary.

Now, submitted herewith is a supplemental reissue oath/declaration of co-inventor Kenneth Pereira which includes the language as follows:

“Every error in the patent which was corrected in the present reissue application, as not covered by a prior oath/declaration submitted in this application, arose without any deceptive intent on the part of the Applicant.”

As a result of the submission of the Declaration of Kenneth Pereira, this issue is believed to have been resolved.

The Claims are not an Improper Recapture

Applicant is very surprised that the Examiner has rejected the claims as being an improper recapture under 35 U.S.C. §251. See *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984). Applicant thoroughly explained in a Preliminary Amendment dated June 19, 2000 why the Recapture Rule did not apply in this case. In a Notice of Allowance dated October 6, 2000, the Examiner indicated that it had considered the communication of June 19, 2000 and considered the claims allowable. Perhaps since more than two years have passed, it was forgotten that the inapplicability of the Recapture Rule had already been recognized.

Notwithstanding, the inapplicability of the Recapture Rule is again set forth as follows.

Recapture Rule

The claims of the present application are not barred by the Recapture Rule. As correctly stated by the Examiner, the Recapture Rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. See *Ball Corp. v. U.S.* Accordingly, the Recapture Rule requires a comparison of the instant claims to the cancelled claims of the original application. The claim from the original application that was cancelled during prosecution is set forth as follows.

1. An integrated telescoping mast-payload assembly comprising:
 - (a) at least two nesting, telescoping mast sections having upper and lower ends,
 - (i) a lower section
 - (ii) a top section, dimensioned to slidably nest within said lower section,
 - (b) means for extending and retracting said top section relative to said lower section from a fully retracted position to a fully extended position,
 - (c) a payload forming the upper end of said top section, at least a portion of said payload being received within said lower section when said top section is fully retracted.

During prosecution of the earlier application, the Examiner correctly recognized that though the claim indicated that the payload forms part of the top section of the mast assembly, with at least a portion of the payload being received within the lower mast section when retracted, the claim did not properly exclude mast assemblies where the payload comprised not only the uppermost section, but were also carried in the lower immediate sections or in the bottom section of the mast assembly. Thus, the claim would read on mast assemblies such as telescoping automobile radio antennas. Recognizing that the invention was directed to a

payload forming a mast section being protected by nonpayload carrying intermediate mast sections, Applicant amended the claim to define a mast assembly wherein the payload was located only in the mast assembly's uppermost mast section. The allowed independent claim is set forth as follows.

1. In a telescoping mast assembly, including:

a plurality of nesting, telescoping mast sections, including a top section and at least one lower section, each of said sections having upper and lower ends, and

means for extending and retracting each of said sections relative to the next-lower section,

the improvement comprising:

a payload, located only in said top section,

said top section, including said payload, being dimensioned to be received and nest within the next-lower section,

at least a portion of said payload being received within said next-lower section when said top section is fully retracted,

such that said next-lower section provides protection for

said payload when said top section is fully retracted,

said payload being a member of the group consisting of radio antennas, lights, instrumentation and telemetry packages for robotic vehicles, television cameras, antenna rotators, preamplifiers, radiation sensors and electronic and electro-mechanical instrument packages. (Claim 1 of U.S. Patent No. 5,615,855)

A review of the claims of the instant application, the cancelled claims of the original application and the allowed claims of U.S. Patent No. 5,615,855 demonstrates that the cancelled claim, by far, is of the broadest scope, covering any telescoping mast assembly wherein a payload is located in the top section of the assembly, but also including constructions where the payload is in a bottom section, or in an intermediate section. The only independent claim of the '855 patent is significantly narrower than the cancelled claim as it covers only telescoping mast assemblies wherein the payload is located only in the top section of the mast assembly. Finally, the claims of the instant application are significantly narrower than the cancelled claim as they include the limitations that the telescoping mast assembly include a plurality of nonpayload carrying intermediate sections (Claims 1 -12), or the telescoping mast assembly includes at least one nonpayload carrying intermediate section for protecting the payload section and an attachment means for attaching the telescoping mast assembly to a vehicle (Claims 13 - 17). Admittedly, the claims of the instant application are broader than the

claims of the '855 patent in one aspect as they are not limited to the payload being located only in the top section of the mast assembly.¹ Accordingly, the scope of the cancelled claims, claims of the '855 patent and claims of the present application can be graphically depicted as follows.

|-----scope of cancelled claims-----|

|-----scope of claims in '855 patent-----|

|-----scope of claims in present application-----|

Now turning back to the Recapture Rule, the Recapture Rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. *Ball Corp. v. U.S.*, 221 U.S.P.Q. § 289, 295 (Fed. Cir. 1984). However, the claims of the present application are clearly narrower in all aspects, not broader or of the same scope, than the cancelled claims.

As also stated in *Ball Corp. v. U.S.*, the recapture prohibition is presumptively avoided as to claims that are, as to the cancelled claims, narrower in some respect and broader only in

¹ The Claims of the present application may be permissibly broader in scope than the '855 patent as the application stems from a reissue application filed within two (2) years of the issue date of the '855 patent. See 35 U.S.C. §251.

respect that are not pertinent to the alleged error. Here, the claims are narrower with respect to the cancelled claims, which permitted the payload to be located in any of the mast sections, and not broader in any other respect. Thus, the Recapture Rule is presumptively avoided.

Also, as more recently stated *In Re Clement*, 131 F.3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997), the following principles flow: (1) if the reissue claims is as broad or broader than the cancelled or amended claim in all respects, the Recapture Rule bars the claim; (2) if it is narrower in all aspects, the Recapture Rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, than: (a) if the reissue claim is as broad or broader as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the Recapture Rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the Recapture Rule does not bar the claim, but other objections are possible.

In the present instance, the claims of the present application are narrower in all aspects, and thus under principal No. 2, the Recapture Rule does not apply. Even if it could be argued that the present claims were broader in an aspect than the cancelled claim, it has certainly been narrowed in an aspect germane to the prior art rejection. In particular, the cancelled claim covered mast assemblies wherein the payload was carried in any of the mast sections, while the present claims have been narrowed to exclude such constructions, having limitations that the

mast assembly include nonpayload carrying intermediate sections for protecting the payload when the mast assembly is retracted.

Because the Recapture Rule is not believed to be applicable, Claims 1 - 17 of the present application are believed allowable.

CONCLUSION

In response to the Examiner's Office Action, Applicant submits herewith the required supplemental reissue oath/declaration. Moreover, Applicant has explained the reasons why the Recapture Rule does not apply. Accordingly, the claims of the present application are believed allowable. Moreover, Applicant would like to remind the Patent Office that the Issue Fee was paid on October 24, 2000.

Respectfully submitted,

DRUMMOND & DUCKWORTH

A handwritten signature in black ink, appearing to read "David G. Duckworth", is written over the printed name.

David G. Duckworth
Registration No. 39,516
Attorneys for Applicant
Telephone: (949) 724-1255